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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,578	08/25/2003	James Edwin Funk	60081-0011	4091

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EXAMINER

MEREK, JOSEPH C

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,578

Applicant(s)

FUNK, JAMES EDWIN

Examiner

Joseph C. Merek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6-8 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 5 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The substitute abstract has been corrected for length but contains the word comprises. The substitute abstract of the disclosure is objected to because it uses the word comprises. This is a legal term that often used in claims. See above. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,872,401) in view of Crawley (US 2002/0025086 A1).

Regarding claim 1, Lee as seen in teaches a container in which a soy or wine sauce is placed with an outer sheath 30 with a plurality of magnets within the outer sheath both near the proximal end and the distal end but does not teach the removable bag in the container. Crawley as seen in 1, teaches a bag for foodstuffs. It would have been obvious to employ the bag or liner of Crawley in the container of Lee to eliminate the need for cleaning the container as taught by Crawley. The structure of the modified container of Lee is capable of performing the claimed function of debris collection and the attraction of metallic debris that enters the removable bag. Lee does not specifically teach that the sheath 30 is made of a non-conductive material. However in the second embodiment Lee teaches that the box as seen in Fig. 2 is made of plastic. It would have been obvious to make the outer sheath 30 of plastic to provide an inexpensive material for the sheath or provide a non-conductive material as taught by Lee in the second embodiment. Regarding claim 2, see Figs. 1 of Lee where the frame is 50. The open end of sheath encompasses the opening of the frame, the open end of the inner bag encompasses the opening of the frame as it is disposed inside of it and the one or more first magnets are coupled near the proximal portion of the frame. Regarding claim 3, the magnets, as seen in Fig. 1 are disposed on both sides of the opening and satisfies the claim limitation. Regarding claim 4, see Fig. 1, where 11 is a magnetically conductive material, i.e. metal. Regarding claim 6, there is no structure that is lacking from the combination of references to perform the claimed function. Regarding claim 7,

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Lee shows members 40 and 50 as being one-piece members in Figs. 1 but not does not teach making members 40 and 50 of plastic. It would have been obvious to make the members of plastic to provide an inexpensive way to form the complex one-piece structures. The process step of the injection molding does not add any structure that is not in the combination of references. Regarding claim 8, the magnet housing is formed between the outer sheath and the inner member 10. The magnets are disposed within the housing. Regarding claim 12, official notice is taken that it is well known to provide a container with a leather exterior. It would have been obvious to make the exterior sheath of Lee leather to make a distinctive or more attractive appearance.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,872,401) in view of Crawley (US 2002/0025086 A1) and admitted prior art. Regarding claim 11, in the previous office action the examiner took official notice that it is well known to provide a container with a wider base than the top portion and to taper the sidewall between the two sizes or diameters. Since applicant did not traverse this rejection it is not admitted prior art. It would have been obvious to make the modified container of Lee more stable and less likely to tip over.

Claims 1, 2, 3, 6-8, 10, 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,872,401) over admitted prior art. Regarding claim 1, as seen in Figs. 2-4, teaches a container for holding cigarettes where the cigarettes are placed into the container within which the cigarettes are placed into the container with the cigarettes have some covering around them as seen in Fig. 3 but does not teach the covering is a bag or has an open proximal end. In the previous office action the

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examiner took official notice that it is well known to contain cigarettes in soft pack of flexible wrappers. Since applicant did not traverse this rejection then it is admitted prior art. It would have been obvious to employ the soft flexible wrapper in the cigarettes of Lee to provide a simple and inexpensive package. Moreover, a hard pack is not required since they go in the case as seen in Fig. 3. It would have been obvious to open the pack to remove the cigarettes for use. The structure is capable of performing the claimed functions. Regarding claim 2, the frame is seen in Fig. 2 as item 62, when 62 is hinged on 60 the functional language of encompassing the openings is satisfied. The flexible package satisfies all the limitations of a bag. Regarding claim 3, see Fig. 4. Regarding claim 6, the magnets seen in Fig. 4 are capable of performing the claimed function. Regarding claim 7, the frame is made of plastic. The process step does not require any structure that is not in the reference. Regarding claim 8, see Figs. 2 and 4, where the magnet housings 63 and 63' are shown. Regarding claim 10, Lee does not teach the magnet housings being made of plastic. It would have been obvious to employ plastic in the magnet housings to provide an inexpensive housing for the magnets. Regarding claim 12, Lee teaches that the outer sheath 60 is plastic but does not teach the case as seen in Figs. 2-4 of Leather. In the previous office action the examiner took official notice that it is well known to provide leather cigarettes cases. It would have been obvious to make the outer sheath of or case of Lee of leather to provide for a durable and distinctive case. Regarding claim 13, it is inherent that the inner bag of Lee will contact some of the magnets shown in Fig. 4.

Response to Arguments

In response to applicant's argument that the intended use of containing debris as well as to attract metallic debris that enters a removable inner bag, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). All of the applied references are capable of performing the claimed function of containing debris and the attraction of the metallic debris. Applicant has not provided any evidence to the contrary.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "position of the second magnet between the bottom of the removable inner bag and the bottom of the outer sheath") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims state that the second magnet is between the distal end of the sheath and the distal end of the liner. The magnets on the lower end of Lee are

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between the distal end of the sheath and the distal end of the liner. The term "distal end" is broad and can include some of the sidewall as seen in Lee. Moreover, the "end" is the part that is near the bottom.

Allowable Subject Matter

Claims 5 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

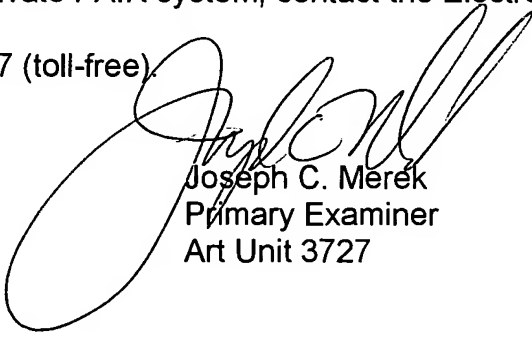
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is 571 272-4542. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (571) 272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merék
Primary Examiner
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